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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,302	12/06/2001	Gennady V. Merkulov	CL001186DIV	5768

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EXAMINER	
PAK, YONG D	
ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/003,302	MERKULOV ET AL.	
	Examiner	Art Unit	
	Yong Pak	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

This application is a divisional of 09/820,001.

Claims 1-23 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-2 and 20-21, drawn to a lipase, classified in class 435, subclass 198.

II. Claims 3, drawn to antibody against the lipase, classified in class 530, subclass 387.9.

III. Claim 4-11 and 22-23, drawn to DNA encoding a lipase, vector comprising said DNA, host cell comprising thereof and a method of producing polypeptide, classified in class 435, subclass 190.

IV. Claims 12, drawn to a method of detecting the presence of the polypeptide, classified in class 435, subclass 26.

V. Claims 13, drawn to a method of detecting the presence of the polynucleotide, classified in class 435, subclass 6.

VI. Claim 14-15, drawn to a method for identifying a compound which modulates the activity of the polypeptide of Invention II, classified in class 435, subclass 26.

VII. Claims 16, drawn to a method for identifying a compound which binds to the polypeptide, classified in class 435, subclass 26.

VIII. Claims 17, drawn to a composition comprising an agent identified by the method of Invention VII, classified in class 514, subclass 789.

IX. Claims 18, drawn to a method for treating or preventing a disease with the agent of Invention VIII, classified in class 514, subclass 789.

X. Claims 19, drawn to a method for identifying an agent which modulate the activity or expression of the polypeptide, classified in class 514, subclass 789.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III and VIII are patentably distinct because a protein, a DNA, an antibody and compound that binds to the protein are different compounds, each with its own chemical structure and function, and they have different utilities. DNA of Inventions II are patentably distinct as encoding enzymes with different structures, functions, substrate specificities, and utilities. The proteins of Inventions I are patentably distinct as having different structures, functions, substrate specificities, and utilities.

The DNA molecule of invention II is not limited in use to the production of polypeptide of invention I, respectively, and can be used as a hybridization probe, and protein of Invention I can be obtained by a materially different method such as by biochemical purification. The structure of an antibody of Invention III is not predictable from the structure of the protein of Invention I and an antibody can cross-react with various proteins.

Inventions I and (IV and VI-VII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1)

the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein of Invention I can be used for the production of the antibody of Invention III.

Inventions I and (V and X) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA of Inventions II can be used for the production of the protein of Invention I or in hybridization assays.

Inventions VIII and (IX) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the agent can be used in in vitro binding assays or in assays to detect the polypeptide in a sample.

The methods of Inventions IV-VII and IX-X are patentably distinct as directed to materially different methods employing different products. Invention V and X uses DNA, Inventions IV and VI-VII use polypeptides, and Invention IX use agents that modulates the activity of the polypeptide.

Further, Inventions IV and VI-VII are patentably distinct because the methods have different effects and utilities. Invention V and X are patentably distinct because the methods have different effects and utilities.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak
Patent Examiner

March 6, 2003

PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
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